



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS-
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,845	07/11/2001	James P. Beck	PH-7222	9511

7590

03/12/2003

Michael L Goldman
Nixon Peabody LLP
Clinton Square
P O Box 31051
Rochester, NY 14603

EXAMINER

ROBINSON, BINTA M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,845

Applicant(s)

BECK ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 20-22, 25, 28, 31, 34-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 23, 24, 26, 27, 29, 30, 32, 33 and 36-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Action

The applicant traverses the restriction requirement alleging that the restriction is inappropriate because the various groups of the invention are related to one another and would necessarily require common areas of search and consideration. However, the examiner notes that the applicant has claimed several independent and distinct inventions that do not share common areas of search. For example when x is varied, the classified can vary from 546 to 544. Additionally, the fact that the radicals R1-R7 can be various heterocyclic rings also varies the areas to be searched. The applicant is only entitled to one independent and disclosed invention. Searching the entire invention as claimed would present an undue burden on the USPTO.

The examiner notes that the elected species and the elected group I does not read on all of claims 1-40, but only reads on claims 1-19, 23-24, 26-27, 29-30, 32-33, 36-40. So the restriction requirement will be revised so that Group I is drawn to claims 1-19, 23-24, 26-27, 29-30, 32-33, 36-40. Claims 20-22, 25, 28, 31, 34-35 are withdrawn from consideration.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19, 23-24, 26-27, 29-30, 32-33, 36-40 are rejected under 35

U.S.C. 112, first paragraph, because the specification, does not provide enablement for

Art Unit: 1625

when R8 and R9 or R10 and R11 are taken together with the nitrogen to which they are attached to form a piperidine, pyrrolidine, piperazine, N-methylpiperazine, morpholine, or thiomorpholine ring. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims as recited are broader than the scope of enablement. The specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. The applicant is referred to *In re Wands*, 858 f.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the incorporation of the 8 factors recited in Ex parte Foreman 230 USPQ 546 (Bd. Of App. And Inter 1986).

Claim 39 is rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for the method of treating all diseases claimed, many of which are unrelated. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The claims as recited are broader than the scope of enablement.

The applicant is referred to *In re Wands*, 858 f.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the incorporation of the 8 factors recited in Ex parte foreman 230 USPQ 546 (Bd. Of App. And Inter 1986).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is

Art Unit: 1625

"undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art 6) the amount of direction provided by the inventor 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In *re Wands*, 858 F. 2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

In terms of the breadth of the claims, R8 and R9 come together to form the heterocyclic rings claimed and R10 and R11 coming together to form the heterocyclic rings claimed encompasses a much wider Markush grouping of radicals than those radicals tested 2) the nature of the invention is that these compounds are useful in the treatment of various neurological and psychological disorders. In terms of the fifth *Wands* factor, the level of predictability in the art is low since no compounds where R8 and R9 or R10 and R11 come together to form the rings claimed are synthesized and tested for their effects on the diseases claimed. No tests were conducted examining the biological effects of any of these compounds on the diseases claimed, or any of the biochemical mechanisms behind the diseases claimed. In terms of the sixth *Wands* factor, the amount of direction provided by the inventor is poor, because the applicant does not synthesize the whole breadth of compounds encompassing all of the moieties that the particular radicals on the compounds can be. In terms of the seventh *Wands* factor, the applicant does not provide any working examples in biological assays.

In terms of the 8th *Wands* factors, undue experimentation would be required to make or use the invention based on the content of the disclosure due to the breadth of

the claims, the level of predictability in the art of the invention, and the poor amount of direction provided by the inventor. Taking the above factors into consideration, it is not seen where the instant claim is enabled by the instant application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 23, 24, 26, 27, 29, 30, 32, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claims 23, 24, 26, 27, 29, 30, 32, and 33, line 4, the phrase "consisting essentially of" is indefinite. The phrase "consisting essentially" of is a phrase that is open language. However, a compound claim can only consist of one compound, and not any other undefined elements.

The elected species is allowable.

The IDS filed 4/10/02 has been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.


Application/Control Number: 09/902,845

Page 6

Art Unit: 1625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

Binta Robinson


March 6, 2003



ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600